

### **REMARKS**

The November 29, 2007 Office Action was based upon pending Claims 1, 2, 5, 6, 9-15, 19, 20 and 22-26. This Amendment amends Claims 1, 9, 11, and 12 without prejudice or disclaimer.

Thus, after entry of this Amendment, Claims 1, 2, 5, 6, 9-15, 19, 20 and 22-26 are pending and presented for further consideration.

### **ISSUED RAISED IN THE OFFICE ACTION**

The November 29, 2007 Office Action rejected Claims 1, 2, 5, 6, 9-15 and 19-25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,154,852 to Amundson, et al. (hereinafter referred to as "Amundson").

### **REJECTION OF CLAIMS 1, 2, 5, 6, 9-15 AND 19-25 UNDER 35 U.S.C. §103(A)**

The Office Action rejected Claims 1, 2, 5, 6, 9-15 and 19-25 under 35 U.S.C. §103(a) as being unpatentable over Amundson.

#### **Claim 1**

Amundson appears to disclose backing up data (136) across multiple tape drives (118) in order to perform load balancing (see col. 3, lines 35–38). When the backed-up data is to be restored, a certain amount of the tapes drives (118) are selected to perform the recovery process to a direct access storage device (DASD) (116) (see col. 12, lines 13–34).

Amundson does not, however, appear to disclose: 1) making a first backup copy of first and second portions of the source data, 2) then making a second backup copy, 3) wherein the second backup copy stores the first and second portions in the first backup copy in a combined format, and 4) restoring the first portion of data by retrieving the first portion of data from the combined format of the second backup copy.

Rather, Amundson appears to store a single backup copy of data on tape drives. Applicant is unable to find any teaching in Amundson where a second backup copy is also stored.

Furthermore, even if Amundson has a second backup copy, Applicant is unable to find any teaching in Amundson where first and second portions of the first backup copy are copied in a combined format to create the second backup copy. In Claim 1, the second backup copy stores the first and second portions of data from the first backup copy, in a combined format. This is significantly different than backup the system disclosed in Amundson.

Also, Claim 1 restores data from the second backup copy in a much different manner than the recovery of data described in Amundson. For example, Amundson fails to disclose recovering a first portion of data by retrieving the first portion of data from the combined format of the second backup copy.

Legal Standard for Obviousness Under § 103

KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007), in no way relieves the Patent Office of its obligation to “consider all claim limitations when determining patentability of an invention over the prior art.” In re Lowry, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (emphasis added). Accordingly, it remains well settled law that a finding of “obviousness requires a suggestion of all limitations in a claim.” CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (emphasis added) (cited in Ex Parte Wada, 2008 WL 142652, \*4 (Bd.Pat.App. & Interf., Jan. 14, 2008)).

In the aftermath of KSR, the Board of Patent Appeals and Interferences has repeatedly reversed findings of obviousness when the Examiner has failed to proffer a prima facie case of obviousness. See, e.g., Wada, 2008 WL 142652 at \*5 (“Because the Examiner has not explained why every limitation in claim 1 would have been obvious to a person of ordinary skill in the art, we agree with Appellants that the Examiner has not made out a case of prima facie obviousness.”) (emphasis added); Ex Parte Challapali, 2008 WL 111346, \*4-6 (Bd.Pat.App. & Interf., Jan. 10, 2008) (reversing finding of obviousness because the Examiner failed to establish sufficient reasoning for combining the references).

The Examiner Has Not Presented a Prima Facie Case of Obviousness

In view of the arguments set forth herein, Appellant submits that Claim 1 is patentable over the cited references based on at least the following reasons:

1) making a second backup copy of a first backup copy, wherein the second backup copy stores first and second portions of data obtained from the first backup copy, and wherein the first and second portions of data are stored in a combined format; and

2) restoring the first portion of data by retrieving the first portion of data from the combined format of the second backup copy.

Thus, in order to establish a prima facie case of obviousness for the pending claims, the Examiner must present, inter alia, references that when relied upon have each and every claim limitation. However, neither Amundson, nor any of the other cited references, even when combined, suggest such limitations. Thus, Appellant respectfully contends that the Examiner has failed to provide adequate articulation of his reasoning to support the legal conclusion of obviousness.

Accordingly, Applicant respectfully requests allowance of Claim 1.

Dependent Claims 2, 5 and 6

Claims 2, 5 and 6 depend from amended independent Claim 1 and are believed to be patentably distinguished over Amundson for the reasons set forth above with respect to Claim 1 and for the additional features recited therein.

Claim 9

With respect to Claim 9, Amundson does not appear to disclose: creating making additional copies of the first and second portions of data wherein the additional copies store the first and second portions of data in a combined format.

Furthermore, Amundson does not restore the first portion of data by retrieving the first portion of data from the combined format of the additional copies.

The Examiner Has Not Presented a Prima Facie Case of Obviousness

In view of the arguments set forth herein, Appellant submits that Claim 9 is patentable over the cited references based on at least the following reasons:

1) making additional copies of primary copies in a tiered storage network, wherein the additional copies store first and second portions of data obtained from the primary copies, and wherein the first and second portions of data are stored in a combined format; and

2) restoring the first portion of data by retrieving the first portion of data from the combined format of the additional copies.

Thus, in order to establish a prima facie case of obviousness for the pending claims, the Examiner must present, inter alia, references that when relied upon have each and every claim limitation. However, neither Amundson, nor any of the other cited references, even when combined, suggest such limitations. Thus, Appellant respectfully contends that the Examiner has failed to provide adequate articulation of his reasoning to support the legal conclusion of obviousness.

Accordingly, Applicant respectfully requests allowance of Claim 9.

Dependent Claim 10

Claim 10 depends from amended independent Claim 9 and is believed to be patentably distinguished over Amundson for the reasons set forth above with respect to Claim 9 and for the additional features recited therein.

Claim 11

Amended independent Claim 11 is believed to be patentably distinguished over Amundson for reasons similar (where applicable) to those set forth with respect to the patentability of independent Claim 9 and for the different aspects recited therein.

Claim 12

Amended independent Claim 12 is believed to be patentably distinguished over Amundson for reasons similar (where applicable) to those set forth with respect to the patentability of independent Claim 9 and for the different aspects recited therein.

Dependent Claims 13 and 14

Claims 13 and 14 depend from amended independent Claim 1 and are believed to be patentably distinguished over Amundson for the reasons set forth above with respect to Claim 1 and for the additional features recited therein.

Dependent Claims 15, 19 and 20

Claims 15, 19, and 20 depend from amended independent Claim 9 and are believed to be patentably distinguished over Amundson for the reasons set forth above with respect to Claim 9 and for the additional features recited therein.

Dependent Claims 22-24 and 26

Claims 22-24 and 26 depend from amended independent Claim 1 and are believed to be patentably distinguished over Amundson for the reasons set forth above with respect to Claim 1 and for the additional features recited therein.

**NO DISCLAIMERS OR DISAVOWALS**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application.

The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution.

Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Application No.: 10/663,384  
Filing Date: September 16, 2003

**CONCLUSION**

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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